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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,504	04/25/2002	Oswald Wolff	WOLFF,D ET AL (PCT)	2655
25889	7590	12/28/2004	EXAMINER	
WILLIAM COLLARD COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			PHAM, HUONG Q	
			ART UNIT	PAPER NUMBER
			3764	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.		Applicant(s)	
	10/018,504		WOLFF ET AL.	
	Examiner		Art Unit	
	Huong Q. Pham		3764	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 November 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claim 4 is objected to because "closing elements " lacks proper antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Epler et al ( 5,135,473). Epler et al shows every claimed feature of the claims including a cuff 30 made of relatively stiff material : neoprene ( note that " stiff" is a relative term, a material which appears " stiff" to one person might appears " not stiff" to another. And note also that the stiffness of a material will also depend on the thickness of that sheet of material ), and pad 20 which is capable of being located in the region of the tibiofibular joint .

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al in view of Wehr ( 5,503,622), or Morris et al ( 5,501,659), or the reference # 3300111. As for claims 3, 5, Wehr teaches a padded cuff made of stiff plastic material, Morris et al teaches rigid shell for an ankle made of rigid molded plastic which can be flexed, reference # 3300111 appears to teach a relatively rigid cuff ( note that in the previous office action, the examiner requested a translation of this document, but applicant has not provided this translation ). In view of the teaching of Wehr ( 5,503,622), or Morris et al ( 5,501,659), or the reference # 3300111 , it would have been obvious to an ordinary skill in the art at the time the invention was made to use stiff plastic for the ankle brace of Epler et al in order to provide better support for a wearer. As for claims 4, note the closing elements in figures 5-6 of Epler et al. Note that the use of belts and buckles for closing elements is well-known in the art. It would have been obvious to an ordinary skill in the art at the time the invention was made to use belts and buckles for closing elements of Epler et al if desired. The substitution of one type of closing elements for another well-known type of closing elements is obvious to an ordinary skilled in the art, and does not provide any unexpected result, and therefore is not patentable over prior art. As for claims 6-7, note the cuff of Morris et al or Wehr is a ring open on one side.

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Claims 6- 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wehr in view of Epler et al . Wehr teaches a cuff with the recited structure which can be opened on one side and being made of stiff plastic material being padded in the inside. Epler et al teaches a device with structure which " leaving the upper ankle joint uncovered". In view of Epler et al , it would have been obvious to an ordinary skill in the art at the time the invention to modify the device of Wehr so that the upper ankle joint is uncovered such that the mobility of the upper ankle joint and the Achilles tendon is not restricted, and the tibiofibular syndesmosis is stabilized.

Claims 8 - 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epler et al in view of Wehr , or Morris et al , or the reference # 3300111 as indicated above, and further in view of Mason et al. See the comments above for the teachings of Wehr , Morris et al , and the reference # 3300111. Note that the device of Mason et al is made of polycarbonate or stainless steel. In view of the teachings of Wehr , or Morris et al , or the reference # 3300111 and Mason et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to use polycarbonate or stainless steel for the device of Epler et al in order to provide the desired stiffness for a wearer.

Claims 8- 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wehr in view of Epler et al , and further in view of Mason et al. See the comments above for the teachings of Wehr and Epler et al . Note that the device

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of Mason et al is made of polycarbonate or stainless steel. In view of the teaching of Mason et al, it would have been obvious to an ordinary skill in the art at the time the invention was made to use polycarbonate or stainless steel for the device of Wehr in order to provide the desired stiffness for a wearer.

Note that the submitted reference # DE 3300111A1 does not have English translation. As requested in the previous office action, applicant is required to submit an English translation of this reference.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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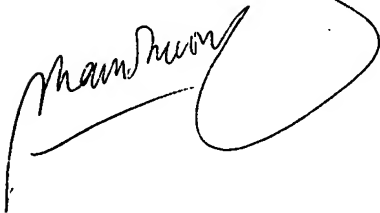
the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272- 4980. The examiner can normally be reached on 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on ( 571) 272 - 4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 23, 2004



  
JUSTINE R. YU  
SUPERVISORY PATENT EXAMINER  
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12/23/04